

REMARKS

I. Status of the Claims

In the Office Action mailed December 16, 2010 ("the Office Action")¹, the Examiner took the following actions:

- (i) rejected claims 1-5, 8-14, 18-21, 23-28, 31-33, 37-41, 46, and 47 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0131721 A1 to Doctorow et al. ("Doctorow"); and
- (ii) rejected claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Doctorow* in view of Official Notice.

By this Amendment, Applicants amends claims 1, 26, and 41. No prohibited new matter has been added. Claims 1-48 remain pending in the present application.

Applicants respectfully traverse the rejections and submit that the pending claims are allowable over the prior art of record for at least the following reasons.

II. Rejection of Claims 1-5, 8-14, 18-21, 23-28, 31-33, 37-41, 46, and 47 under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1-5, 8-14, 18-21, 23-28, 31-33, 37-41, 46, and 47 under 35 U.S.C. § 102(e) as being anticipated by *Doctorow*.

In order to properly establish that a reference anticipates Applicants' claims under 35 U.S.C. § 102, each and every element as set for the in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131., 8th Ed., Rev. 7 (July, 2008, (emphasis added)). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Doctorow fails to disclose or suggest, all of the features of the claims including, among other things, "determining whether the content has been previously shared by the sharing user. . . presenting, to the sharing user, a visual representation indicating that the content has been previously shared when the content is determined to be previously shared . . . [and] determining a set of recipient candidates likely to be interested in the content based upon the classification of the content and prior sharing activity of the recipients with respect to content of the same or similar classification," as recited in amended independent claim 1.

Doctorow discloses:

the degree of commonality is assessed by maintaining a record of the number of occurrences each user A to E accepts information from each other user A to E. . . if user A was previously provided with information from user B and user A accepted the information from user B, a record of this occurrence could be made at step 42. The number of such occurrences would be recorded and used in the future to assess the degree of commonality between user A and user B at step 44. Likewise, at step 46 a record is made of the number of occurrences each user does not accept information from each other user. A comparison of this information can be made at step 48 to assess the degree of commonality. Paragraphs [0049]-[0050].

Thus, in *Doctorow* the degree of commonality is determined by a number of occurrences of a user accepting or rejecting information provided by a different user. Such a disclosure, however, does not constitute or teach the claimed "determining a set of recipient candidates likely to be interested in the content based upon the classification of the content and **prior sharing activity** of the recipients **with respect to content of the same or similar classification**," as recited in claim 1 (emphasis added). This is at least because the degree of commonality in *Doctorow* is simply determined based on a number of occurrences of a user accepting or rejecting

information. There is no disclosure in *Doctorow* of determining a number of occurrences of a user accepting or rejecting "content of the same or similar classification," as recited in claim 1.

In contrast, paragraph [0052] of *Doctorow* discloses that "even if it is determined. . . that user A and user C have several common areas of interest, such as categories x and z, if user A repeatedly does not accept information provided by user C, the degree of commonality between user A and user C will be assessed downwards." Thus, the comparison of prior information sharing in *Doctorow* is limited to the number of occurrences a user accepts or rejects information from a particular user and is not based on "prior sharing activity of the recipients with respect to content of the same or similar classification," as recited in claim 1 (emphasis added).

Moreover, *Doctorow* also does not teach or suggest "determining whether the content has been previously shared by the sharing user" and "presenting, to the sharing user, a visual representation indicating that the content has been previously shared when the content is determined to be previously shared," as further recited in claim 1. As noted above, *Doctorow* discloses determining a number of occurrences a user accepts or rejects information from a particular user. See also *Doctorow*, Fig. 4B. There is simply no disclosure in *Doctorow* of determining a particular content has been previously shared and/or presenting a visual representation indicating that the content has been previously shared.

For at least the above reasons, *Doctorow* fails to disclose or suggest each and every element of independent claim 1 and, therefore, claim 1 should be allowed.

Amended independent claims 26 and 41 although of different scope, contain features

similar to those discussed above for claim 1, and therefore are also allowable over the cited reference for at least reasons similar to those discussed above for claim 1. Claims 2-5, 8-14, 18-21, 23-25, 27, 28, 31-33, 37-40, 46, and 47 depend from one of the allowable independent claims 1, 26, and 41, and are also allowable at least due to their dependence from an allowable base claim, and further in view of the additional features recited by these claims.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-5, 8-14, 18-21, 23-28, 31-33, 37-41, 46, and 47 under 35 U.S.C. § 102(e) is respectfully requested and deemed appropriate.

III. Rejections of Claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Doctorow* in view of *Official Notice*. A *prima facie* case of obviousness has not been established with respect to these claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P.* § 2141(ii). In rejecting a claim, "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48 depend from one of the allowable independent claims, and thus require all the elements of their base claims. As set forth above, *Doctorow* fails to teach or suggest each and every element of independent claims 1, 26, and 41. Moreover, *Official Notice* does not compensate for the deficiencies of *Doctorow*. This is at least because *Official Notice* also does not teach or suggest a "presenting, to the sharing user, a visual representation indicating that the content has been previously shared when the content is determined to be previously shared . . . [and] determining a set of recipient candidates likely to be interested in the content based upon the classification of the content and prior sharing activity of the recipients with respect to content of the same or similar classification."

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established for independent claims 1, 26, and 41, or dependent claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48. The dependent claims should also be allowed in view of the additional features recited by these claims.

Moreover, on pages 4-6 of the Office Action, the Examiner has relied on conclusory statements and personal knowledge to reject claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48, while acknowledging the deficiencies of *Doctorow* to teach the features recited in these claims. However, the Examiner's apparent reliance on personal knowledge and/or conclusory statements to form a basis for a *prima facie* case of obviousness is improper.

MPEP § 2144.03 states, “[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner **must provide an affidavit or declaration** setting forth specific factual statements and explanation to support the finding.” (Emphasis added). The Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” See MPEP § 2144.03. Applicants submit that “[d]eficiencies of the cited references cannot be remedied by . . . general conclusions about what is ‘basic knowledge’ or ‘common sense.’” In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicants submit that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicant to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made,” or else withdraw the rejection. See MPEP § 2144.03.

For at least these additional reasons, a *prima facie* case of obviousness has not been established for dependent claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48. Accordingly, the Examiner should withdraw the 35 U.S.C. § 103(a) rejection of claims 6, 7, 15-17, 22, 29, 30, 34-36, 42-45, and 48 and allow these claims in the next official communication.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Philip J. Hoffmann
Reg. No. 46,340